

Appl. No. 10/723,994  
Amdt. dated December 19, 2005  
Response to Office Action mailed September 19, 2005

### **REMARKS/ARGUMENTS**

Applicants respectfully request reconsideration of this application in view of the foregoing amendments to claims and the following comments.

In the Office Action mailed September 19, 2005, pending claims 1-7, 20-25, and 27-39 were rejected under 35 U.S.C. § 103(a), as follows:

- Claims 1-7, 25, 27-39, based on U.S. Patent No. 6,007,434 to Baker et al. (the "Baker patent");
- Claims 20-24, based on the Baker patent in view of specified "Official Notices";
- Claims 1-4, 6, 7, 25, 28-39, based on U.S. Patent No. 6,110,057 to McKinnon (the "McKinnon patent");
- Claims 20-24, based on the McKinnon patent in view of specified "Official Notices";
- Claims 1-4, 6, 7, 28-39, based on U.S. Patent No. 4,964,641 to Miesch et al. (the "Miesch patent");
- Claims 20-24, and 27, based on the Miesch patent in view of specified "Official Notices";
- Claims 29-39, based on U.S. Patent No. 5,688,190 to Rowland et al. (the "Rowland patent").

Applicant respectfully traverses these rejections for the reasons set forth below.

### **Obviousness Rejections of Claims 1-7, 20-25, and 27-39 over the Baker Patent**

As mentioned above, claims 1-7, 25, 27-39 were rejected under 35 U.S.C. § 103(a), as allegedly obvious over the Baker patent, and claims 20-24 were similarly rejected over the Baker patent in view of specified "Official Notices."

Appl. No. 10/723,994  
Amdt. dated December 19, 2005  
Response to Office Action mailed September 19, 2005

The Baker patent discloses a golf putter head including a forward striking face having a plurality of pyramid-like projections 16a disposed across its surface. These pyramid-like projections are contiguous with each other, with no separation distance between adjacent projections. This structure differs significantly from Applicants' claimed invention.

Independent claim 1 defines a golf club head including a forward striking face having an engineered texture configured to include a recessed surface and a prescribed, regular pattern of discrete, geometric shapes projecting forward from the recessed surface. The geometric shapes are defined to be spaced apart from each other by at least 0.1 mm, and each geometric shape is defined to have a volume of less than 0.0007 mm<sup>3</sup>. In addition, and specifically to clarify the intended meaning of the original language of claim 1, Applicants have now amended the claim to define the recessed surface to be "*substantially planar*" and to define the geometric shapes to be spaced apart from each other by the specified amount "*along the recessed surface*." The substantially planar recessed surface, therefore, must lie between adjacent geometric shapes.<sup>1</sup>

The Baker patent fails to disclose any such recessed surface from which the geometric shapes project forward. In addition, because its geometric shapes are contiguous with each other, they are not spaced apart from each other by specified minimum amount along such a recessed surface. A wholesale modification of the Baker golf putter head, therefore, would be required to arrive at Applicants' claimed invention. For these reasons, the rejection of independent claim 1 based on the Baker patent is improper and should be withdrawn.

Independent claim 29 is directed to a wedge-type golf club head including a forward striking face having a recessed surface and a plurality of discrete geometric shapes projecting from the surface, each such shape having a specified maximum volume and being separated from adjacent shapes by a specified minimum distance. In addition, claim 29 has now been amended in the same manner as independent claim 1, i.e., defining the recessed surface to

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<sup>1</sup> Applicants also have amended independent claim 1 to delete language relating to an enhanced performance provided by the claimed engineered texture. That language is not deemed necessary for patentability.

Appl. No. 10/723,994  
Amdt. dated December 19, 2005  
Response to Office Action mailed September 19, 2005

be “*substantially planar*” and defining the geometric shapes to be separated from each other by the specified minimum distance “*along the recessed surface*.”<sup>2</sup>

As discussed above, the Baker patent fails to disclose any such recessed surface from which the geometric shapes project. In addition, because its geometric shapes are contiguous with each other, they are not separated from each other by the specified minimum distance along the recessed surface. A wholesale modification of the Baker golf putter head, therefore, would be required to arrive at Applicants’ claimed invention. For these reasons, the rejection of independent claim 29 based on the Baker patent is improper and should be withdrawn.

Claims 2-7, 25, 27, and 28 all depend from amended independent claim 1, and claims 30-39 all depend from amended independent claims 29. These dependent claims add structural features that further distinguish over the disclosure of the cited Baker patent. For these reasons, and for the reasons set forth above with respect to amended independent claims 1 and 29, the rejections of these dependent claims based on the Baker patent are improper and should be withdrawn.

**Obviousness Rejections of Claims 1-4, 6, 7, 20-25, and 28-39 over the McKinnon Patent**

As mentioned above, claims 1-4, 6, 7, 25, and 28-39 were rejected under 35 U.S.C. § 103(a), as allegedly obvious over the McKinnon patent, and claims 20-24 were similarly rejected over the McKinnon patent in view of specified “Official Notices.”

The McKinnon patent discloses a golf putter head including an array of rigid spikes 16 projecting forward from a striking face. The spikes are said to impart an immediate top spin motion to a golf ball. Importantly, the spikes are expressly specified to be *hollow*, and the patent lacks any suggestion of modifying the spikes to be solid.

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<sup>2</sup> Independent claim 29 also has been amended to correct an inadvertent error in the specified volume threshold. The threshold 0.007 mm<sup>3</sup> has been corrected to 0.0007 mm<sup>3</sup>. Support for this correction can be found, *inter alia*, in original claim 1. Similar corrections have been made to dependent claims 30, 31, and 35.

Appl. No. 10/723,994  
Amdt. dated December 19, 2005  
Response to Office Action mailed September 19, 2005

The McKinnon putter head structure differs significantly from Applicants' claimed invention. By this Amendment, independent claims 1 and 29 have been amended to specify that the discrete geometric shapes projecting from a recessed surface of a forward striking face are "*solid*." This distinguishes over the McKinnon golf putter head structure, whose discrete geometric shapes are expressly specified to be *hollow*. Moreover, the Examiner has failed to identify any suggestion in the McKinnon patent, or elsewhere, that the spikes be modified to be solid.

For these reasons, the obviousness rejections of independent claims 1 and 29 based on the McKinnon patent are improper and should be withdrawn.

Claims 2-4, 6, 7, 20-25 and 28 all depend from amended independent claim 1, and claims 30-39 all depend from amended independent claim 29. These dependent claims add structural features that more particularly define the invention and thus further distinguish over the disclosure of the McKinnon patent. For these reasons, and for the reasons set forth above with respect to independent claims 1 and 29, the obviousness rejections of dependent claims 2-4, 6, 7, 20-25, 28, and 30-39 based on the McKinnon patent are improper and should be withdrawn.

**Obviousness Rejections of Claims 1-4, 6, 7, 20-24, and 27-39 over the Miesch Patent**

As mentioned above, claims 1-4, 6, 7, and 28-39 were rejected under 35 U.S.C. § 103(a), as allegedly obvious over the Miesch patent, and claims 20-24 and 27 were similarly rejected over the Miesch patent in view of specified "Official Notices."

The Miesch patent discloses a golf putter head including an array of four-sided pyramids 56 projecting forward from a striking face 54. The pyramids define a contiguous array, as shown in FIGS. 2 and 3 of the drawings, with no separation distance between adjacent pyramids. As such, the Miesch structure is akin to the structure of the Baker patent, discussed above.

The Miesch golf putter head structure differs significantly from Applicants' claimed invention. As discussed above in connection with the obviousness rejection based on the Baker patent, independent claims 1 and 29 both define a golf club head having a pattern of

Appl. No. 10/723,994  
Amdt. dated December 19, 2005  
Response to Office Action mailed September 19, 2005

discrete, geometric shapes projecting from a substantially planar recessed surface, wherein such geometric shapes are spaced apart, or separated, from each other by a specified minimum amount "along the recessed surface." This effectively excludes patterns of geometric shapes that are contiguous with each other such that they lack any intervening portion of a substantially planar recessed surface.

For these reasons, the obviousness rejections of independent claims 1 and 29 based on the Miesch patent are improper and should be withdrawn.

Claims 2-4, 6, 7, 20-24, 27, and 28 all depend from amended independent claim 1, and claims 30-39 all depend from amended independent claim 29. These dependent claims add structural features that more particularly define the invention and thus further distinguish over the disclosure of the Miesch patent. For these reasons, and for the reasons set forth above with respect to independent claims 1 and 29, the obviousness rejections of dependent claims 2-4, 6, 7, 20-25, 27, 28, and 30-39 based on the Miesch patent are improper and should be withdrawn.

#### **Obviousness Rejections of Claims 29-39 over the Rowland Patent**

As mentioned above, claims 29-39 were rejected under 35 U.S.C. § 103(a), as allegedly obvious over the Rowland patent.

The Rowland patent discloses several embodiments of a removable adhesive-backed pad 10 configured for application to a golf club striking surface. As shown in the patent's drawings, the disclosed pad embodiments include (1) "tungsten carbide granules of varying shapes" (FIGS. 1-4); (2) a "rubber-coated material [having] the rough textured feel of a fine grit sandpaper" (FIG. 8); (3) an array of contiguous ribs 38 (FIGS. 5-7); or (4) an array of contiguous pyramids 48 (FIGS. 9-11). These structures all differ significantly from the structure of Applicants' claimed invention.

The forward projections of Rowland's first two specified embodiments (i.e., FIGS. 1-4 and 8) are *variably sized and shaped*, and they are located in a *random* pattern on the pad. These projections thus fail to constitute a regular pattern of discrete, geometric shapes.

Appl. No. 10/723,994  
Amdt. dated December 19, 2005  
Response to Office Action mailed September 19, 2005

Further, the forward projections of Rowland's second two specified embodiments (i.e., FIGS. 5-7 and 9-11) are *contiguous* with each other and thus lack any separation distance between them.

As discussed above, independent claim 29 defines a golf club head having discrete geometric shapes projecting from a substantially planar recessed surface, wherein such geometric shapes are separated from each other by a specified minimum amount "*along the recessed surface.*" In addition, claim 29 has now been amended to specify that these discrete geometric shapes are arranged in "*a regular pattern.*" This claim language effectively excludes the disclosed embodiments of the Rowland patent, which include either (1) *random* arrangements of *variably shaped* projections, or (2) patterns of *contiguous* geometric shapes lacking any intervening portion of a substantially planar recessed surface.

For these reasons, the obviousness rejection of independent claim 29 based on the Rowland patent is improper and should be withdrawn.

Claims 30-39 all depend from amended independent claim 29, adding structural features that more particularly define the invention and thus further distinguish over the disclosure of the Rowland patent. For these reasons, and for the reasons set forth above with respect to independent claim 29, the obviousness rejections of dependent claims 30-39 based on the Rowland patent are improper and should be withdrawn.

#### Telephone Interview

Applicants thank the Examiner for his courtesy in granting a brief telephone interview with their undersigned representative on December 16, 2005. Although the cited references and the amended claims were not discussed during the interview, the Examiner indicated that if Applicants amended the claims to define structure not shown or suggested in the cited references, he would withdraw his previous request for a showing of unanticipated, or surprising, results.

Appl. No. 10/723,994  
Amdt. dated December 19, 2005  
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**Amendment to the Title of the Invention**

This Amendment also amends the Title of the Invention to reflect Applicants' prior response to a restriction requirement, which canceled all claims directed to a method of manufacturing.

**Conclusion**

The foregoing remarks and amendments to the claims should place this application in condition for allowance. If the Examiner believes that a telephone conference with Applicants' undersigned representative might expedite the prosecution of the application, he is respectfully requested to call at the telephone number indicated below. As indicated in the accompanying transmittal form, please charge any fees due in connection with this filing to our Deposit Account No. 19-1853.

Date: December 19, 2005

Respectfully submitted,

SHEPPARD, MULLIN, RICHTER & HAMPTON LLP

By: \_\_\_\_\_

  
James R. Brueggemann  
Registration No. 28,286

333 South Hope Street, 48th Floor  
Los Angeles, California 90071  
Telephone: (213) 620-1780 x4156  
Facsimile: (213) 620-1398